

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANFRED SCHMIDT, PETER VEHLEWALD, PETER KASPEREK,
MANFRED KAPPS, BERGISCH GLADBA and KLAUS KONIG

Appeal No. 1997-3620
Application No.08/386,795

ON BRIEF

Before JOHN D. SMITH, PAK and PAWLIKOWSKI, **Administrative Patent Judges.**

PAWLIKOWSKI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 through 17, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The subject matter on appeal relates to a process of making a composite material by (1) combining a material, such as a cellulose-containing and/or lignocellulose material, with a composition comprising an aromatic polyisocyanate and a polyester having an average molecular weight of from 600 to about 5000 obtained by self-condensation of ricinoleic acid alone or by condensation of ricinoleic acid with a C₂-C₂₀ starter polyol, and (2) molding the same at a temperature of from about 180⁰C to about 250⁰C.

Further details of this appealed subject matter are set forth in representative independent claim 10 that reads as follows:

10. A process for the production of a composite material comprising
 - a) combining material to be bonded with a composition comprising 1) an aromatic polyisocyanate and 2) a polyester having an average molecular weight of from 600 to about 5000 obtained by self-condensation of ricinoleic acid alone or by condensation of ricinoleic acid with a C₂-C₂₀ starter polyol, and optionally 3) an additive and
 - b) molding or compressing the product of a) at a temperature of from about 180 to about 250⁰C.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Legue et al. (Legue)

4,340,682

July 20, 1982

Claims 10 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Legue '682.

As indicated by the examiner on page 3 of the Answer (and not contested by the appellants), the claims on appeal stand or fall together. 37 CFR § 1.192(c)(7)(1995).

OPINION

An important consideration for the examiner's § 103 rejection concerns the process requirements of claim 10 of molding or compressing the product formed in step a) of claim 10, i.e., molding or compressing a product resulting from combining a "material to be bonded"¹ with a composition comprising 1) an aromatic polyisocyanate and 2) a polyester having an average molecular weight of from 600 to about 5000 obtained by self-condensation of ricinoleic acid alone or by condensation of ricinoleic acid with a C₂-C₂₀ starter polyol, and optionally 3) an additive, at a temperature of from about 180⁰C to about 250⁰C, for the production of a composite material.

It is appellants' position that Legue '682 is not pertinent prior art as it concerns an adhesive composition, rather than a molding process for the production of a composite material. Legue '682 is directed to adhesive compositions (col. 1, lines 8-12), especially adhesive compositions having improved green strength (col.1, lines 44-68, col.2, lines 1-10).

Obviousness under § 103 is a legal conclusion based upon facts revealing the scope and content of prior art, the differences between prior art and the claims at issue, the level of ordinary skill in the art, and objective evidence of nonobviousness. **Graham v. John Deere Co.**, 86 S.Ct. 684, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). The scope and content of the prior art is that which is

¹ The phrase "material to be bonded" is found in the specification, on page 7, at lines 2-3, and refers to the materials identified on page 6, lines 23-27 and page 7, lines 1-5 of the specification. The materials include, *inter alia*, wood, bark plastic wastes of all kinds, etc.

reasonably pertinent to the particular problem with which the inventor was involved. **Stratoflex, Inc. v. Aeroquip Corp.**, 713 F.2d 1530, 1535, 218 USPQ (BNA) 871, 876 (Fed. Cir. 1983).

In this case, the appropriateness of the scope and content of the prior art is in dispute. Legue '682 is directed to adhesive compositions, while appellants' claim 10 is directed to a molding process for the production of composite materials.

Nothing in the record correlates the disclosed adhesive compositions of Legue '682 with achieving desirable characteristics in a molding process for the production of composite materials, such as satisfactory mold release properties.

The examiner states that "one of ordinary skill in the art would have been able to model ricinoleate-based adhesive compositions for a wide array of adhesive applications, including the production of composites" (Answer, page 7). However, the record is silent as to why one of ordinary skill in the art would use the adhesive composition in Legue '682 in a molding process, having desirable properties, such as mold release properties, for the production of a composite material. Therefore, in concluding that obviousness was established by the teachings in Legue '682, the examiner has ignored the principle that there must have been something present in those teachings to suggest to one skilled in the art that the claimed invention would have been obvious. **In re Bergel**, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (CCPA 1961);

In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 244 (CCPA 1969). Accordingly, inadequate factual foundation exists to support the legal conclusion of obviousness.

CONCLUSION

To summarize, the decision of the examiner to reject claim Claims 10 through 17 under 35 U.S.C. § 103 as being unpatentable over Legue '682 is reversed.

REVERSED

JOHN D. SMITH)
Administrative Patent Judge)
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CHUNG K. PAK)
Administrative Patent Judge)
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